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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,859	03/22/2001	Robert L. Monroe	01 P 5275 US	5439
7590 01/04/2005			EXAMINER	
Elsa Keller Siemens Corporation 186 Wood Avenue South Iselin, NJ 08830			LE, VIET Q	
			ART UNIT	PAPER NUMBER
			2667	

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/815,859		MONROE ET AL.	
	Examiner		Art Unit	
	Viet Q. Le		2667	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28-31 is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/22/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The US application number is missing on page 1 of the specification.

Appropriate correction is required.

2. The disclosure is objected to because of the following informalities: The specification describes mobile station 106 for figure 1 on line 1 of page 5. However, there is no mobile station 106 in figure 1.

Appropriate correction is required.

3. The abstract of the disclosure is objected to because the title of the application should not be on the abstract page. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "software" recited in the claims is not clear which software it refers to.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 4-6, 8-13, 15-16, 18-21, 23-24, 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefan Parkvall et al. (US 2002/0080719), hereafter referred to as Parkvall and in view of Fen-Chung Kung et al. (US 6,633,635), hereafter referred to as Kung.

Regarding claims 1, 12 and 20, Parkvall disclosed a method for providing user notification, comprising of generating a mobile-terminated message containing at least a portion of information to be provided to a mobile station (Parkvall disclosed a message coming from application residing in box 14 of Fig. 9); communicating the mobile-terminated message to a base station (See Fig. 9, box 28), the base station operable to communicate the mobile-terminated message to the mobile station (See Fig. 9, box 30); determining if the mobile station acknowledges successful receipt of the mobile-terminated message (Parkvall disclosed that if the base station does not receive any acknowledgement message from the user, the base station will keep attempting sending the message to the same user. See page 6, column 2, and paragraph 57).

Parkvall fails to explicitly disclose that the base station will be generating a mobile-originated message containing at least a portion of the information for communication to a public network if the mobile station fails to acknowledge successful receipt of the mobile-terminated message, the public network operable to communicate the mobile-originated message to the mobile station.

Kung disclosed the overall network connection between the IP network and public network and the traffic compatibility when going through one another network. (Kung discloses the overall network flexibilities when traffic can travel back and forth between the IP network and the public network with no problem. Traffic can originate from the IP network and terminate at the public network and vice versa. See Fig. 2; see column 6, lines 43-56).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the base station of Parkvall with the capabilities of communicating the mobile station through the PSTN as taught by Kung so that the mobile-originated message can originate from the base station to the mobile stations either directly or going through another adjacent network like the public network to the same intended mobile stations, the motivation being that by going through the public network, the messages will have an alternate route of getting to the destination and releasing the base station buffer of memory space for other future packets to be sent to the mobile stations.

Regarding claims 2, 13 and 21, Parkvall disclosed the mobile terminated message is communicated to the mobile station through the base station without being

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routed through the public network (Messages are transmitted directly from the applications inside the box 14 directly to the base station 28 without going through the public network. See Fig. 9; See page 6, column 1, paragraphs 53-54).

Regarding claims 4, 15 and 23, Parkvall disclosed information to be communicated to the mobile station from an application (Messages from applications are transmitted directly from the applications inside the box 14 directly to the base station 28. See Fig. 9; See page 6, column 1, paragraphs 53-54).

Regarding claim 5, Parkvall however, fails to disclose the information comprises of a text message.

Kung disclosed information to be in the form of the text message (See column 20, lines 47-50).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to realize that the mobile-originated message sent from the application can be in the form of the text message, the motivation being that using the text message format, users will have another option of receiving the messages from the application either in the voice format or in the text format.

Regarding claims 6, 16 and 24, Parkvall, however, fails to disclose the method receiving a signal indicating that a voice mail device has received a voice message and generating a text message indicating that the voice mail device has received the voice message, the text message comprising the information to be provided to the mobile station.

Kung disclosed that user defined messages can be generated for voice mail messages generated in the IP network (Either user defined messages or pre-defines messages can be generated to support voice mail, email or video mail services. See column 11, lines 30-48). These messages can be in the form of the text messages (See column 20, lines 47-50).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to realize that text messages are sent from the application like voice mail services/servers when one receive the message, the motivation being that using the text message format, users will have another option of receiving the messages when one receiving a new message from the application like the voice mail application.

Regarding claims 8, 18 and 26, Parkvall discloses plurality of base stations, serving the mobile stations; and wherein communicating the mobile-terminated message to at least one base station serving the mobile station (Messages are sent from application in box 14 to at least one base station and then to the designated mobile station associated with its base station. See Fig. 9).

Regarding claims 9, 19 and 27, Parkvall does not disclose forwarding the information to the public network; and wherein communicating the mobile-originated message to the public network comprises communicating the mobile-originated message to the public network based on the forwarding determination.

Kung disclosed the overall network connection between the IP network and public network and the traffic compatibility when going through one another network.

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(Kung discloses the overall network flexibilities when traffic can travel back and forth between the IP network and the public network with no problem. Traffic can originate from the IP network and terminate at the public network and vice versa. See Fig. 2; see column 6, lines 43-56).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to forward the mobile message information to the public network if there is no acknowledgement back from the user terminals, the motivation being that by going through the public network, the messages will have an alternate route of getting to the destination and releasing the base station buffer of memory space for other future packets to be sent to the other mobile stations.

Regarding claims 10-11, Parkvall, however, fails to disclose the method using the inter-working unit intended for the mobile-originated message operating between a first protocol (IP) for the packet network and a second protocol (SS7) for the public network.

Kung disclosed that disclose the method using the inter-working unit intended for the mobile-originated message operating between a first protocol (IP) for the packet network and a second protocol (SS7) for the public network (protocol conversions are required when traffic are going from the public network to the IP network or to the SS7 network. See column 3, lines 30-42; column 4, lines 64-67; column 5, lines 11-36; column 6, lines 27-42).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the protocol conversion into the method to make

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sure that messages have the proper protocol when going from the IP network to the SS7 network or from the SS7 network to the IP network, the motivation being that messages will be able to go across different networks with no problem.

8. Claims 3, 14, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parkvall (US 2002/0080719) in view of Kung (US 6,633,635) and in further view of Pecen (U.S. 6,631,259).

Regarding claims 3, 14, 22, Parkvall and Kung, however, fail to disclose the mobile message to be Global system for mobile communication (GSM) short message.

Pecen discloses mobile message to be complying with the Global system for mobile communication (GSM) short message standard (See column 1, lines 13-27).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to realize that the mobile-originated message have to comply to GSM standard, the motivation being that by complying to the GSM standard, the messages will all be compatible when traveling through a GSM network.

9. Claims 7, 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parkvall (US 2002/0080719) in view of Kung (US 6,633,635) and in further view of Schneider (U.S. 6,570,871).

Regarding claims 7, 17 and 25, Parkvall, however, fails to disclose the method further comprising of receiving the subscriber location register for an approval to communicate the information to the mobile station.

Schneider disclosed the subscriber location register granting approval to communicate the information to the mobile station (The Subscriber Location Register

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(SLR), as described by Schneider, stores the actual subscribers to the wireless communication. If the destination telephone number is not identified in the SLR, the destination telephone number is not part of the wireless digital communication system. See column 13, lines 56-67; see column 14, lines 1-9).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the subscriber location register (SLR), the motivation being that the SLR can store the actual subscribers and the visiting subscribers to the wireless communication system. If the telephone number is not identified in the SLR, the call cannot be completed.

Allowable Subject Matter

10. Claims 28-31 is allowed.

The reason for allowance is because examiner could not find any previous art that disclose as many limitations as in the claims.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Thomas M. Sladek et al. (U.S. 6,622,016), System for controlled provisioning of telecommunication services.

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- b) Juha Matti Pirkola et al. (U.S. 6,611, 516), Short message service support over a packet switched telephony network.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Q. Le whose telephone number is 571-272-2246.

The examiner can normally be reached on 8 AM -5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on 571-272-3139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

vi


RICKY NGO
PRIMARY EXAMINER